

REMARKS

Applicants respectfully request further examination and reconsideration in view of the instant response. Claims 1, 3-16, 18 and 20-26 are pending in the application. Claims 1, 3-18 and 20-26 are rejected. Claim 17 has been canceled herein without prejudice. No new matter has been added.

PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE AN OFFICE ACTION

The instant Response to Office Action is filed concurrent a Petition to Withdraw the Holding of Abandonment Based on Failure to Receive and Office Action.

REQUIREMENT FOR INFORMATION

The instant Office Action includes a Requirement for Information under 37 CFR §1.105 regarding the ownership of the instant application and the right to assign such ownership interests. Applicants have submitted a Response to the Requirement for Information herewith in a separate paper.

REJECTIONS

35 U.S.C. §112 Paragraph 2 – Claim 17

The Office Action mailed May 21, 2007, rejected Claim 17 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, and for the Claim 17, therefore, being vague, ambiguous and of indeterminable scope. Particularly, the Office Action states that “The scope of the claim is unclear as it appears to reiterate a limitation that already exists in parent claim

10.” Claim 17 has been canceled herein without prejudice. Thus, the rejection under 35 U.S.C. §112 Paragraph 2 has been rendered moot.

REJECTIONS

35 U.S.C. §103(a) – Claims 1, 3-4 and 10-16

The present Office Action rejected Claims 1, 3-4, and 10-16 under 35 U.S.C. 103(a) as being unpatentable over Hong Su et al. (“Identification of Syntactically Similar DTD Elements for Schema Matching”, The Second International Conference on Web-Age Information Management (Waim 2001), Xi'an, China, July 2001, pp. 1-13, hereafter referred to as “SchemaMatching.”) in view of Hong Su et al. (“XEM: Managing the Evolution of XML documents”, Eleventh International Workshop on Research Issues in Data Engineering (RIDE 2001), Heidelberg, Germany, April 1-2, 2001, pp. 1-8, hereafter referred to as “XEM”) and further in view of Hellman et al. (US Patent Application Publication No. 2004/0216030, filed via continuation on May 25, 2001, and published Oct. 28, 2004, hereafter referred to as “Hellman”). Applicants have reviewed the cited references and respectfully submit that the embodiments of the present invention as recited in Claims 1, 3-4, and 10-16 are patentable over SchemaMatching in view of XEM and further in view of Hellman for at least the following rationale.

Applicants respectfully assert that the rejection under 35 U.S.C. §103(a) is improper as Hellman does not qualify as prior art. Under 35 U.S.C. §103, prior art includes references with effective dates before the effective filing date of the invention. Applicants respectfully assert that the Hellman reference does not qualify as prior art because the Hellman reference can be antedated under 37 CFR §1.131 as the Applicants' invention was reduced to practice prior to the effective date of the Hellman

reference. Specifically, the antedating reference to Hellman is prior to November 5, 2001, predating the January 15, 2002, effective filing date of the Hellman reference.

Applicants respectfully assert that the present invention was reduced to practice prior to the effective date of the reference, Hellman, Publication No. 2004/0216030. That is, the present invention was reduced to practice prior to November 5, 2001, which is prior to the effective filing date of Hellman, Publication No. 2004/0216030, January 15, 2002, with respect to Applicants' embodiments of Claims 1, 10 and 18. Declarations under 37 CFR §1.131 from all the inventors attesting to these facts were filed earlier with the response filed on December 12, 2005.

Specifically, a copy of the paper entitled, "Automating the Transformation of XML Documents," hereinafter referred to as "the Transformation Paper," was offered in the response filed on December 12, 2005 as Exhibit A in each of the declarations by the inventors. The authors of the paper include Hong Su, Harumi Kuno, and Elke A. Rundensteiner, all inventors of the present invention.

The Transformation Paper is directed to the discovery of transformation operations between two XML schemas of the present Application. Exhibit A of the Office Action response filed December 12, 2005, demonstrates that the present invention was reduced to practice.

Additionally, each of the declarations of the inventors attest to the fact that the creation of the Transformation Paper entitled, "Automating the Transformation of XML Documents," occurred prior to November 5, 2001 which is prior to the effective filing

date of the Hellman application filed on January 15, 2002, which recites new matter that allegedly reads on Applicants' embodiments of Claims 1, 10 and 18.

Applicants respectfully note that the Hellman reference, Publication No. 2004/0216030, claims priority to Parent Patent Application, Application No. 09/866,101, filed on May 25, 2001. However, there is no evidence that the subject matter upon which the Examiner has based the rejection under 35 U.S.C. §103(a) is included in the Parent Application. Applicants have reviewed the Parent Patent Application, Application No. 09/866,101, and submit that the subject matter upon which the Examiner has based the present rejection is not included in the Parent Patent Application, Application No. 09/866,101. Applicants respectfully request that Examiner withdraw the present rejection under 35 U.S.C. §103(a) that Claims 1, 3-4, and 10-16 are unpatentable under SchemaMatching in view of XEM and further in view of Hellman, as Hellman does not qualify as prior art.

Moreover, Applicants respectfully assert that the claimed embodiments are not unpatentable over SchemaMatching in view of XEM. Specifically, SchemaMatching in view of XEM does not teach, describe or suggest the claimed embodiments as recited in Claims 1 and 10. Applicants respectfully assert that SchemaMatching in view of XEM does not teach, describe or suggest the claimed embodiments as recited in Claims 1 and 10 and that these claims are allowable over SchemaMatching in view of XEM.

As described above, Applicants respectfully assert that the Hellman reference does not qualify as prior art because the Hellman reference can be antedated under 37

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CFR §1.131 as the present invention was reduced to practice prior to the effective date of the Hellman reference. Moreover, Applicants respectfully assert that the claimed embodiments are patentable over SchemaMatching in view of XEM. Specifically, SchemaMatching in view of XEM does not teach, describe or suggest the claimed embodiments as recited in Claims 1 and 10, and that these claims are allowable. Therefore, Applicants respectfully submit that Claims 3-4 and 11-16 overcome the rejection under 35 U.S.C. § 103(a) as these claims are dependent on allowable base claims, Claims 1 and 10, respectively.

35 U.S.C. §103(a) – Claims 17-18 and 20-21

In the Office Action, the Examiner rejects Claims 17-18 and 20-21 under 35 U.S.C. §103(a) as being unpatentable over SchemaMatching in view of XEM and further in view of Hellman and Swamy et al. (US Patent No. 6,874,141) hereinafter “Swamy”. Applicants respectfully submit that Claim 17 has been canceled without prejudice rendering the rejection of Claim 17 moot. In addition, Applicants have reviewed the cited references and respectfully submit that the embodiments of the present invention as recited in Claims 18 and 20-21 are patentable over SchemaMatching in view of XEM and further in view of Hellman and Swamy for the following rationale.

Applicants respectfully assert that the rejection under 35 U.S.C. §103(a) is improper as Hellman does not qualify as prior art. Under 35 U.S.C. §103, prior art includes references with effective dates before the effective filing date of the invention. Applicants respectfully assert that the Hellman reference does not qualify as prior art because the Hellman reference can be antedated under 37 CFR §1.131 as the

Applicants' invention was reduced to practice prior to the effective date of the Hellman reference. Specifically, the antedating reference to Hellman is prior to November 5, 2001, predating the January 15, 2002, effective filing date of the Hellman reference.

As described above, Applicants respectfully assert that the Hellman reference does not qualify as prior art because the Hellman reference can be antedated under 37 CFR §1.131 as the present invention was reduced to practice prior to the effective date of the Hellman reference. Moreover, Applicants respectfully assert that the claimed embodiments are patentable over SchemaMatching in view of XEM and further in view of Swamy. Specifically, SchemaMatching in view of XEM and further in view of Swamy does not teach, describe or suggest the claimed embodiments as recited in Claim 18 and that Claim 18 is allowable. Therefore, Applicants respectfully submit that Claims 20-21 overcome the rejection under 35 U.S.C. § 103(a) as these claims are dependent on allowable base Claim 18.

35 U.S.C. §103(a) – Claims 5-9

In the Office Action, the Examiner rejects Claims 5-9 under 35 U.S.C. §103(a) as being unpatentable over SchemaMatching in view of XEM and further in view of Hellman and in view of Peter Buneman et al. ("UnQL: A Query Language and Algebra for SemiStructured Data Based on Structural Recursion", The VDLB Journal, issue No. 9, Springer-Verlag, (c) 2000, pp. 76-110, hereinafter referred to as "Buneman". Applicants have reviewed the cited references and respectfully submit that the embodiments of the present invention as recited in Claims 5-9 are patentable over SchemaMatching in view of XEM and further in view of Hellman and Buneman for the following rationale.

Applicants respectfully assert that the rejection under 35 U.S.C. §103(a) is improper as Hellman does not qualify as prior art. Under 35 U.S.C. §103, prior art includes references with effective dates before the effective filing date of the invention. Applicants respectfully assert that the Hellman reference does not qualify as prior art because the Hellman reference can be antedated under 37 CFR §1.131 as the Applicants' invention was reduced to practice prior to the effective date of the Hellman reference. Specifically, the antedating reference to Hellman is prior to November 5, 2001, predating the January 15, 2002, effective filing date of the Hellman reference.

As described above, Applicants respectfully assert that the Hellman reference does not qualify as prior art because the Hellman reference can be antedated under 37 CFR §1.131 as the present invention was reduced to practice prior to the effective date of the Hellman reference. Moreover, Applicants respectfully assert that the claimed embodiments are patentable over SchemaMatching in view of XEM and further in view of Buneman. Specifically, SchemaMatching in view of XEM and further in view of Buneman does not teach, describe or suggest the claimed embodiments as recited in Claim 1 and that Claim 1 is allowable. Therefore, Applicants respectfully submit that Claims 5-9 overcome the rejection under 35 U.S.C. § 103(a) as these claims are dependent on allowable base Claim 1.

35 U.S.C. §103(a) – Claims 22-26

In the Office Action, the Examiner rejects Claims 22-26 under 35 U.S.C. §103(a) as being unpatentable over SchemaMatching in view of XEM and further in view of Hellman, Swamy and Buneman. Applicants have reviewed the cited references and

respectfully submit that the embodiments of the present invention as recited in Claims 22-26 are patentable over SchemaMatching in view of XEM and further in view of Hellman, Swamy and Buneman for the following rationale.

Applicants respectfully assert that the rejection under 35 U.S.C. §103(a) is improper as Hellman does not qualify as prior art. Under 35 U.S.C. §103, prior art includes references with effective dates before the effective filing date of the invention. Applicants respectfully assert that the Hellman reference does not qualify as prior art because the Hellman reference can be antedated under 37 CFR §1.131 as the Applicants' invention was reduced to practice prior to the effective date of the Hellman reference. Specifically, the antedating reference to Hellman is prior to November 5, 2001, predating the January 15, 2002, effective filing date of the Hellman reference.

As described above, Applicants respectfully assert that the Hellman reference does not qualify as prior art because the Hellman reference can be antedated under 37 CFR §1.131 as the present invention was reduced to practice prior to the effective date of the Hellman reference. Moreover, Applicants respectfully assert that the claimed embodiments are patentable over SchemaMatching in view of XEM and further in view of Swamy and Buneman. Specifically, SchemaMatching in view of XEM and further in view of Swamy and Buneman does not teach, describe or suggest the claimed embodiments as recited in Claim 18 and that Claim 18 is allowable. Therefore, Applicants respectfully submit that Claims 22-26 overcome the rejection under 35 U.S.C. § 103(a) as these claims are dependent on allowable base Claim 18.

CONCLUSION

In light of the amendments and arguments presented herein, Applicants respectfully request reconsideration of the rejected Claims for allowance thereof.

Based on the arguments presented above, Applicants respectfully assert that Claims 1, 3-16, 18 and 20-26 overcome the rejections of record. Therefore, Applicants respectfully solicit allowance of these Claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

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